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Amendment
Attorney Docket No. S63.2B-10059-US01

REMARKS

This Amendment After Final is in response to the Final Office Action dated February 7, 2005, wherein claim 32 was rejected under 35 U.S.C. §112, second paragraph; claims 23, 25-26, 29, 33-36 and 38-39 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. 6,123,712 to Di Caprio et al (hereinafter: Di Caprio); claims 27 and 37 were rejected under 35 U.S.C. §103(a) as being obvious over Di Caprio in view of U.S. 6,251,136 to Guruwaiya et al (hereinafter Guruwaiya); and claims 40-42 were rejected under 35 U.S.C. §103(a) as being obvious over Di Caprio.

The following comments are presented in the same order and with paragraph headings and numbers corresponding to the Final Office Action

Claim Rejections – 35 USC §112

1. In the Final Office Action claim 32 was rejected under §112, second paragraph because it depended from a cancelled independent claim. As indicated above however, claim 32 has been cancelled without prejudice or disclaimer.

Claim Rejections – 35 USC §102

2. In the Final Office Action claims 23, 25-26, 29, 33-36 and 38-39 were rejected under §102(b) as being anticipated by Di Caprio. The Final Office Action directs the Applicant to various features of FIGs. 1-2 of Di Caprio which purported as anticipating the respective features recited in the instant claims. Applicants must respectfully note however, that features of Di Caprio to which the Final Office Action describes as reading on elements of the instant claims are not relevant to the features of the instant claims, and thus cannot be considered as providing a teaching of such elements.

For example: in the Final Office Action Di Caprio is said to have a “removable loading tool (11)...where the tool body has a hollow chamber (10), and where the chamber has an inner surface region (20) which further defines a substantially hollow neck portion at the proximal end of element 19...” In Di Caprio element “11” is not a guidewire loading tool as the instant claims recite, but rather “a guide catheter” (see Di Caprio FIGs. 1-2 and column 6, lines 17-25). In the instant claims the guidewire loading tool is described as *defining* a substantially

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hollow chamber, wherein the chamber has an inner surface region which further *defines* a substantially hollow neck portion in fluid communication with the first portion of the substantially hollow chamber and the second portion of the substantially hollow chamber, and wherein the neck portion diameter tapers from the inner diameter of the first portion to the inner diameter of the second portion of the chamber. Nowhere in Di Caprio, is there any teaching or suggestion that the guide catheter 11 *defines* a substantially hollow chamber which has an inner surface that further *defines* a neck region having a tapering diameter. The only tapered structure which the Final Office Action attempts to read on the instant claim is "inner surface region (20)", which is not *defined* by element 11 or its chamber, as the instant claims describe, but is rather a separate structure altogether (element 20 is in fact a balloon cone see Di Caprio column 6, lines 49-51). Thus, not only does Di Caprio fail to teach or suggest a catheter assembly having all of the elements of the instant claims, it is clear that Di Caprio fails to teach or suggest any aspect of the removable guidewire loading tool described therein.

In light of the above the rejection is respectfully traversed.

Claim Rejections – 35 USC §103

3. In the Final Office Action claims 27 and 37 were rejected as being obvious over Di Caprio in view of Guruwaiya. In the Final Office Action Di Caprio is said to disclose the invention as substantially recited but fails to disclose a drug coating. Guruwaiya is said to teach such a coating. It is asserted in the Final Office Action that it would be obvious to modify the assembly of Di Caprio with the drug coating of Guruwaiya.

In response, it is respectfully asserted that in order to reject a claim under §103, there must be some teaching or suggestion in the art which provides one of ordinary skill in the art the necessary motivation to attempt the proposed combination or modification (see MPEP 2143.01). The Final Office Action fails to describe any aspect of the cited art which would provide the necessary motivation to combine the cited references. For this reason alone the rejection is respectfully traversed.

It must also be noted however, that as indicated above, Di Caprio fails to teach or suggest all of the elements of the instant claims. The addition of Guruwaiya's drug coating, regardless of any motivation (or lack thereof) to combine it with the system of Di Caprio does

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nothing to address the failure of Di Caprio alone to teach or suggest all of the elements of the instant claims.

In the Final Office Action claims 40-42 were rejected under §103 as being obvious over Di Caprio. The Final Office Action states that it would be a matter of design choice to modify the inner diameter of the first portion of the inner region to be about 0.5 mm to about 5 mm. As indicated above, Di Caprio fails to teach or suggest all of the elements of the instant claims. The proposed modification to Di Caprio would do nothing to address the failure of Di Caprio to teach or suggest all of the elements of instant claim 23, from which claims 40-42 depend.

Conclusion

In view of the foregoing, Applicants believe that the present application, with claims 23, 25-27, 29, and 33-43 pending, is in condition for allowance. Favorable consideration and prompt action to that effect are earnestly requested.

Should the Examiner believe that anything further would be desirable to put the application in better condition for allowance, the Examiner is invited to contact the Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

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Date: May 6, 2005

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